

Attorney Docket: 060258-0279296
Client Reference: 2980338US/HM/KP



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF

Confirmation Number: 2811

AHOLA et al.

Group Art Unit: 2685

Appln. No.: 09/806,463

Examiner: NGUYEN, THUAN T

Filed: May 31, 2001

Title: METHOD OF DETERMINING HOME AREA FOR SUBSCRIBER TERMINAL, AN ASSOCIATED RADIOSYSTEM AND A SUBSCRIBER NETWORK ELEMENT

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April 6, 2005

PETITION UNDER 37 C.F.R. §§ 1.144 AND 1.181 FOR REVIEW AND

WITHDRAWAL OF RESTRICTION REQUIREMENT

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated January 6, 2005, in which the May 19, 2004 Restriction Requirement was made FINAL, Applicants hereby request that: 1) the Restriction Requirement be withdrawn; 2) a new Office Action on the merits of all pending claims be issued; and 3) the period for reply be restarted as of the mailing date of the new Office Action. Applicants timely traversed the May 19, 2004 Restriction in a Reply to Restriction Requirement filed June 18, 2004.

The Office Action dated January 6, 2005, justified the use of restriction practice over unity of invention practice on the grounds that "PCT practice and the US Patent Examination is somewhat different and [do] not necessary follow the same concept." (*See* paragraph 7). However, MPEP 1893.03(d) states that "Examiners are reminded that unity of invention (not

restriction) practice is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371." (Emphasis added. See also 37 C.F.R. §1.499). Because the present application is a national stage application of PCT/FI99/00813, filed October 1, 1999, submitted under 35 U.S.C. § 371, Applicants respectfully point out that unity of invention practice, not restriction practice, is applicable here. For at least this reason, Applicants respectfully submit that the restriction requirement is improper.

Furthermore, Applicants respectfully submit that claims 1-20 have unity of invention and should not be subject to restriction. MPEP 1893.03(d) states that "The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept." (Emphasis added). MPEP 1893.03(d) also states that "A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature." The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key." (Emphasis added).

In the present application, claims 1-20, restricted by the Office Action, are linked to form a single general inventive concept. Claims 1-7, 11-13, and 17-20 included in Group I are respectively directed to a method for determining a home area for a subscriber terminal and a system adapted to carry out the method. The subscriber network element claims (Group II, claims 8 and 14) and subscriber terminal claims (Group III, claims 9-10 and 15-16) are respectively directed to components and apparatus that are adapted to carry out the method of the Group I claims, and that form a part of the system of the Group I claims.

Because claims 1-20 each define a solution in which a subscriber terminal transmits measurement results as a response to a command transmitted based upon predetermined conditions, claims 1-20 include a common technical feature. Accordingly, Applicants

respectfully submit that claims 1-20 are linked to form a single general inventive concept with a technical relationship. As such, they share unity of invention and cannot be subject to restriction. Furthermore, no objections as to unity of invention were raised during the international phase of the present application. This provides further support for the correctness of Applicants' analysis herein.

Furthermore, even under restriction practice, Applicants respectfully submit that the Restriction Requirement is improper. MPEP § 808 states that "Every requirement to restrict has two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween." (Emphasis added.)

It is respectfully submitted that the July 30, 2001 Restriction Requirement fails to establish any reasons why the inventions *as claimed* are independent or distinct. Page 2, paragraph 3, and page 3, paragraphs 4-6, of the Restriction Requirement merely state as a conclusion that Inventions I, II and III are independent and distinct. The Restriction Requirement fails to provide any reasons as set forth in MPEP §§ 806.04+ or 806.05+ to support the conclusion that Inventions I, II and III are independent or distinct, respectively. In particular, the Restriction Requirement fails to set forth any analysis of how Invention I is independent or distinct from Invention II, how Invention I is independent or distinct from Invention III and how Invention II is independent or distinct from Invention III, as is required for a three way restriction requirement.

It is also respectfully submitted that the subject matter of all of the "inventions" is sufficiently related that a thorough search and examination of any one group would necessarily encompass the search and examination for all of the "inventions". MPEP §803 states that "If the search and examination of an entire application can be made without a serious burden, the examiner must examine it on the merits, even though it include claims to independent or distinct inventions." (Emphasis added.) In addition, MPEP §803 also states that there are two criteria for a proper restriction requirement: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner.

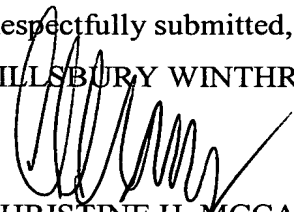
It is respectfully submitted that the search and examination of the entire application can be made without serious burden. Accordingly, the May 19, 2004 Restriction Requirement fails to establish that a serious burden on the examiner exists and is improper.

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Reconsideration and withdrawal of the Restriction Requirement, issuance of a new Office Action on the merits of all pending claims, and a restarting of the period for reply are thus respectfully requested.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
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